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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|--|-------------|----------------------|---------------------|------------------|
| 10/675,644 | 09/30/2003 | Anthony J. Gounalis | L0562.70037US00 | 6075 |
| 7590 | 01/31/2006 | | EXAMINER | |
| Randy J. Pritzker Wolf, Greenfield & Sacks, P.C. 600 Atlantic Avenue Boston, MA 02210 | | | GREGORY, BERNARR E | |
| | | | ART UNIT | PAPER NUMBER |
| | | | 3662 | |

DATE MAILED: 01/31/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

| | | |
|------------------------------|------------------------|----------------------|
| Office Action Summary | Application No. | Applicant(s) |
| | 10/675,644 | GOUNALIS, ANTHONY J. |
| | Examiner | Art Unit |
| | Bernarr E. Gregory | 3662 |

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) Responsive to communication(s) filed on ____.
- 2a) This action is **FINAL**. 2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) Claim(s) ____ is/are allowed.
- 6) Claim(s) 1-20 is/are rejected.
- 7) Claim(s) ____ is/are objected to.
- 8) Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on ____ is/are: a) accepted or b) objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. ____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) Notice of References Cited (PTO-892)
- 2) Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.

- 4) Interview Summary (PTO-413)
Paper No(s)/Mail Date ____.
- 5) Notice of Informal Patent Application (PTO-152)
- 6) Other: ____.

Art Unit: 3662

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 1-20 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Throughout claims 1-20, it is unclear in context what is meant by “configuration.” Does “configuration” refer to the internal configuration of a single receiver?

Throughout claims 1-20, it is unclear in context what is meant by “context.”

Throughout claims 1-20, it is unclear in context what is meant by “relative cost.”

Dependent claims 4-7 are indefinite and unclear in context in that they are dependent from an independent method claim (i.e., claim 1), but each of them fails to recite even a single method step. The same problem occurs with claims 14-17, which depend from computer-implemented method step 11.

Dependent claim 6 is indefinite and unclear in context in that the dependency is typed incorrectly on the first line of the claim. The dependency of claim 6 from “claim 14” must be corrected to the proper dependency.

Throughout claims 1-20, the uses of “scan solution” (e.g., lines 1-2 of claim 9) are indefinite and unclear in context.

Throughout claims 1-20, the uses of “first receiver configuration”; “second receiver configuration”; and “third receiver configuration” are indefinite and unclear in context. For example, do these mean that there are three receivers?

Independent claim 1 is indefinite and unclear in that the preamble of claim 1 presents the claim as a “method for configuring,” but there is no recitation of “configuring” or of acts that together amount to “configuring” in the body of claim

1. The same problem occurs with the computer-implemented method in independent claim 11.

Dependent claims 2-10 and 12-20 are unclear in that they depend from unclear independent claims 1 and 11.

3. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 1-20 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

The method as recited in method claims 1-10 and in computer-implemented method claims 11-20 are non-statutory in that they are directed merely to an abstract calculation based on compared cost of two options without any post-solutional activity of practical utility. It is noted that there is no step or steps for configuration of a receiver in either sets of claims. Each set of claims merely makes an abstract comparison of alternative configurations and makes an abstract choice of configuration without ever making a positive physical action that results from the comparison and/or choice. Method involving only abstract calculations or manipulations are not statutory under 35

USC 101 in that such methods fail to fall into one of the statutory classes for invention under 35 USC 101 since they are not "useful."

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

The examiner-cited prior art is of general interest for showing the general state of the related prior art.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bernarr E. Gregory whose telephone number is (571) 272-6972. The examiner can normally be reached on weekdays from 7:30 AM to 4:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thomas H. Tarcza, can be reached on (571) 272-6979. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should

you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



Bernarr E. Gregory
Primary Examiner
Art Unit 3662